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REMARKS

The Examiner contends that the *Chasin* reference discloses the 'less than 1%' element as found in (for example) previously presented claim 1. The Examiner contends that "one can set the confidence level [of *Chasin*] at any level to a 90 or 95 percent or higher to limit the number of false positives" and, in that regard, "*Chasin* does teach the erroneous classification probability is less than 1%." *Advisory Action*, 2.

Chasin lacks the specific teachings as presently set forth in the Applicants' independent claim 1. Per *Chasin*, the high confidence level value—while *approaching* 100 percent—could be (*i.e.*, the confidence ratio is) 80%, which would constitute an erroneous classification probability of 20%, or 90%, which would constitute an erroneous classification probability of 10%. In both cases, the high value would be greater than 1 percent with respect to an erroneous classification probability and would not meet each and every limitation as set forth in independent claim 1. Less than one percent—as presently recited—means just that: *less than one percent*. As "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art," *Chasin* (alone or in combination) fails to disclose an erroneous classification of less than one percent. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (emphasis added).

There is no indication in *Chasin* that the erroneous classification probability is less than 1%. To suggest the presence of this teaching would be an unsupported extrapolation of the purported teachings of *Chasin*. See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (finding that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic); see also *In re Robertson*, 169 F.3d 743, 745 (stating that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference' as 'inherency . . . may not be established by probabilities or possibilities'") (emphasis added).

The *Chasin* reference never explicitly states that the minimum scores and confidence levels result in an erroneous classification level of less than 1%. See *Chasin*, [0052]. *Chasin* states nothing more than such scores/levels *may be* higher than 95 percent; the fact that the score/level *may be* higher than 95 percent does not mean that its corresponding confidence level *is* less than 1%. For example, a score / level of 96% would constitute a score / level of greater than 95 percent but it would not teach the Applicants' presently claimed limitation of an erroneous classification level of less than 1%.

When the prior art discloses a range which touches or overlaps the claimed range but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to patentability. See MPEP § 2131.03(II). For example, in the context of anticipation, "[i]f the claims are directed to a narrow range, and the reference teaches a broad range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims. See MPEP § 2131.03(II) (citing *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006)).

While the Applicants appreciate that a 35 U.S.C. § 103(a) rejection (with respect to the range itself) *may be* permitted if it is unclear that the reference teaches the range with 'sufficient specificity,' "[t]he examiner must . . . provide . . . a motivational statement regarding obviousness." MPEP § 2131.03(II) (citing *Ex Parte Lee*, 31 U.S.P.Q.2d 1105 (3d. Pat. App. & Inter. 1993) (emphasis added)). Further, a rejection of obviousness with respect to the range itself must "take differences [between the cited and claimed ranges] into account." MPEP § 2131.03(III) (citing *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985)). In this context, the Federal Circuit's holding in the matter of *In re Harris* is of particular relevance wherein it was found that if the disclosed range of a cited reference is so broad as to encompass a large number of possibilities that the

situation becomes analogous to the obviousness of a species when the prior art broadly disclosed a genus. See *In re Harris*, 409 F.3d 1339 (Fed. Cir. 2005).

If the Examiner insists that the *Chasin* references does, in fact, teach an erroneous classification level of less than 1%, the Applicants not only traverse the obviousness of such a range but also the operability of the *Chasin* reference with respect to this particular range. See *In re Hoeksema*, 399 F.2d 269 (CCPA 1968) (requiring that a cited reference have an enabling disclosure). As noted by the Federal Circuit, mere naming or description of the subject matter is insufficient with respect to enablement. See *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). The Applicants contend that *Chasin*—at best—merely names or describes a possibility of approaching 1%.

If *Chasin* were capable of operating at less than a 1% erroneous classification rate, then *Chasin* would have stated the same. The Applicants contend that there is no reason why *Chasin* would only disclose operability within an express and specific range (i.e., 90 to 95 percent) if *Chasin* was, in fact, capable of operating in excess of 99% unless *Chasin* was incapable of doing so. In that regard, the Applicants contend that *Chasin*'s failure to disclose operation in excess of 99% (resulting in an erroneous classification of less than 1%) suggests that it could not operate within that range while still operating within the legal confines of best mode and enablement as required by 35 U.S.C. § 112, ¶ 1.

Andrews et al. also fails to disclose an erroneous classification probability, much less one that is less than 1% per the Applicants' claim 1. As this particular claim element is not found in *Chasin* or *Andrews et al.*—either individually or in combination—the Examiner has failed to evidence a *prima facie* case of obviousness and the 35 U.S.C. § 103(a) rejection is overcome. See MPEP § 2142. Independent claims 20, 23, 24, 28, 29, 30, and 31 all recite a similar limitation and are allowable for reasons similar to those as set forth in the context of claim 1.

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CONCLUSIONS

The Examiner's obviousness rejection of claims 1, 20, 23, 24, and 28-31 are overcome in that the presently cited references—either alone or in combination—fail to disclose an erroneous probability rate of less than 1%.

The Applicants respectfully request the passage of the present application to allowance. The Examiner is invited to contact the Applicants' undersigned representative with any questions concerning this matter.

Respectfully submitted,
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